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OFFICE OF PETITIONS

In re Application of
Soulanille et al.
Application No. 09/915,801
Filed: July 26, 2001
Attorney Docket No. 9623/338

Decision on Petitions

This is a decision on the petition under 37 CFR 1.137(b), filed June 7, 2005, to revive the above-identified application. This is also a decision on the renewed petition under 37 CFR 1.78(a)(3), filed June 7, 2005, to accept the unintentionally delayed priority claims set forth in a concurrently filed amendment.

The petition under 37 CFR 1.137(b) is **granted**.

The petition under 37 CFR 1.78(a)(3) is **granted**.

The petition under 37 CFR 1.137(b)

A final Office action was mailed January 13, 2004.

A petition under 37 CFR 1.78(a)(3) was filed July 12, 2004, along with payment for a 3 month extension of time.

The petition was dismissed on October 21, 2004, because the amendment filed July 12, 2004, impermissibly sought to incorporate by reference the contents of application no. 09/872,737.

The decision stated, "The file will now be forwarded to the examiner to determine if the proposed amendment raises new issues which will require further consideration and/or search."

Prior to the Office of Petitions receiving a response from the examiner, a renewed petition and new amendment were filed November 4, 2004.

The examiner considered the November 4, 2004 amendment and determined the amendment failed to *prima facie* place the application in condition for allowance because the amendment raised new issues that would require further consideration.

Since a proper reply was not timely filed to the final Office action, the application was deemed abandoned as of midnight on July 13, 2004.

A decision stating the application was abandoned and dismissing the petition under 37 CFR 1.78(a)(3) was mailed March 9, 2005.

A Notice of Abandonment was mailed April 7, 2005.

The instant petition under 37 CFR 1.137(b) requests revival of the application.

Petitioner has submitted the required petition fee. Petitioner has submitted a reply to the final Office action in the form of a Request for Reconsideration and amendment. Petitioner has stated the entire delay in filing the required reply from the due date for the reply until the filing of the instant petition was unintentional.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b). Therefore, the petition is granted and the application is revived.

The petition under 37 CFR 1.78(a)(3)

When an application is filed on or after November 29, 2000, benefit claims under 35 U.S.C. 119(e), 120, 121 and 365(c) must be made during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. For the instant application, the above period of time ended on November 26, 2001. The priority claim at issue was not made by this date. However, petitioner has submitted a petition under 37 CFR 1.78(a)(3) which allows one to make late priority claims if certain criteria are satisfied.

Per 37 CFR 1.78(a)(3), a petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

- (1) The reference required by 37 CFR 1.78(a)(2), unless previously submitted;
- (2) The surcharge set forth in § 1.17(t); and
- (3) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

Petitioner has satisfied the requirements listed above.

The granting of this petition is not a determination that petitioner is actually entitled to the benefit of the filing date of the prior-filed applications, but is only a determination that the Office will allow petitioner to file an untimely claim for priority. The examiner will, in due course, consider any priority claims and determine the extent to which the application is entitled to an earlier filing date.

A corrected Filing Receipt, which includes the priority claims, accompanies this decision on petition.

A fee of \$1,370 was improperly charged to petitioner's deposit account for the petition under 37 CFR 1.78(a)(3). However, the petition was previously paid on July 14, 2004. Therefore, the \$1,370 fee will be credited back to petitioner's deposit account.


Summary:

The petition under 37 CFR 1.137(b) is granted.

The petition under 37 CFR 1.78(a)(3) is granted.

This application is being forwarded to Technology Center Art Unit 2161 for appropriate action on the amendment and Request for Continued Examination. **The examiner should consider the priority claims and determine the extent to which the application is entitled to an earlier filing date based on the prior-filed applications.**

Telephone inquiries concerning this decision should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.


Frances Hicks
Petitions Examiner
Office of Petitions

Attached: Corrected Filing Receipt